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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/784,663

02/23/2004

Andrew J. Vilcauskas JR.

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08/23/2006

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EXAMINER

WASSUM, LUKE S

ART UNIT

PAPER NUMBER

2167

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/784,663	Applicant(s) VILCAUSKAS ET AL.	
	Examiner Luke S. Wassum	Art Unit 2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 20-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20040813</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***The Invention***

1. The claimed invention is drawn to a method of presenting advertisements in a computer system through the use of popunder windows. Alternative claimed embodiments are implemented in other media, such as a PDA, telephone, television and radio.

### ***Priority***

2. The Applicants' claim to domestic priority under 35 U.S.C. § 120 as a divisional application based upon application 09/866,425, filed 24 May 2001, which claims priority under 35 U.S.C. § 119(e), to provisional application 60/207,698, filed 26 May 2000, is acknowledged. Since the subject matter of the parent provisional application encompasses that of the instant application and claims, a priority date of 26 May 2000 is hereby established.

### ***Response to Preliminary Amendment***

3. The Applicants' preliminary amendment, filed 10 August 2004, has been received, entered into the record, and considered.

4. As a result of the amendment, claims 1-19 have been canceled, and new claims 20-39 have been added. Claims 20-39 are now presented for examination.

*Information Disclosure Statement*

5. The Applicants' Information Disclosure Statement, filed 13 August 2004 (a duplicate of which was received on 13 December 2004), has been received and entered into the record.

The examiner notes that a number of non-patent references were not included in the Applicants' submission, nor were they located in the file wrapper of the parent application. In addition, two patent references' numbers did not correspond to the inventor name listed on the IDS. These references were not considered.

See attached form PTO-1449.

*Double Patenting*

6. Claims 20-39 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 21-40 of copending Application No. 09/866,425. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 20-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Landsman et al.** (U.S. Patent Application Publication 2003/0004804) in view of **Porn Rodeo** ("source code of [www.pornrodeo.com](http://www.pornrodeo.com) as of 15 November 1999").

11. Regarding claim 20, **Landsman et al.** teaches a system for Internet advertising for use in a media capable of simultaneously maintaining a foreground window and at least one background window and capable of displaying a first browser in a said foreground window for selectively browsing the Internet substantially as claimed, said system comprising:

- a) a script handler that invokes a post-session procedure in said first browser (see disclosure that HTML advertising tags are embedded in a web page, Abstract; see also Figures 2A and 2B); and
- b) an event handler that receives, from an Internet address, a link to an advertisement and loads said advertisement (see paragraphs [0003], [0016], [0017], [0036]-[0038], [0087], [0095], [0107] and [0109]).

**Landsman et al.** does not explicitly teach a system wherein said post-session procedure opens a second browser in a background window while said first browser is simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window.

**Porn Rodeo**, however, teaches a system wherein said post-session procedure opens a second browser in a background window while said first browser is simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window (see `window.open` and `window.focus` calls on page 1, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time of the invention to open a browser in the background and load the advertisement directly into the browser, since this would allow the display of the advertisement to the user (by moving the browser window to the foreground) without the need to open a new window, load any required player files, and load and render the advertisement, thus speeding the display of the advertisement to the user.

12. Regarding claim 30, **Landsman et al.** teaches a post-session advertising method for use in media capable of simultaneously maintaining a background window and a foreground window, said method comprising the steps of:

- a) embedding post-session instructions into a first browser, said first browser for being displayed in said foreground window (see disclosure that HTML advertising tags are embedded in a web page, Abstract; see also Figures 2A and 2B);
- b) said post-session instructions receiving, from an Internet address, a link to an advertisement (see discussion of a request for, and receipt of, an AdDescriptor file, a text file containing a list of file names and corresponding URLs at which these files reside, paragraphs [0103] through [0107]); and
- c) loading said advertisement (see paragraph [0107]).

**Landsman et al.** does not explicitly teach a method wherein said post-session instructions open a second browser in a background window while said first browser is simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window.

**Porn Rodeo**, however, teaches a method wherein said post-session procedure opens a second browser in a background window while said first browser is simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window (see `window.open` and `window.focus` calls on page 1, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time of the invention to open a browser in the background and load the advertisement directly into the browser, since this would allow the display of the advertisement to the user (by moving the browser window to the foreground) without the need to open a new window, load any required player files, and load and render the advertisement, thus speeding the display of the advertisement to the user.

13. Regarding claims 21 and 31, **Porn Rodeo** additionally teaches a system and method wherein said second browser is opened in response to a load-triggering event (see `window.open` call on page 1, lines 16-17, showing that the load-triggering event was the loading of the porn rodeo web page).

14. Regarding claims 22 and 32, **Porn Rodeo** additionally teaches a system and method wherein said load-triggering event comprises at least one of clicking on an off-site link, entering a new address, refreshing a web site, exiting a web site, and being redirected to a web site (see window.open call on page 1, lines 16-17, showing that the load-triggering event was the loading of the porn rodeo web page, analogous to both refreshing a web site and being redirected to a web site, since both would entail the loading of the web page).

15. Regarding claims 23, 24, 33 and 34, **Landsman et al.** additionally teaches a system and method wherein said script handler delays invocation of said post-session procedure for a predetermined period of time, and wherein said script handler cancels invocation of said post-session procedure if a user loads a new web site in said first browser before said predetermined time period has elapsed (see disclosure of the timer based frame targeted advertisements, paragraph [0159]).

16. Regarding claims 25 and 35, **Landsman et al.** additionally teaches a system and method wherein said second browser is displayed in a foreground window after the occurrence of a view-triggering event (see paragraphs [0037] and [0038]).

17. Regarding claims 26 and 36, **Landsman et al.** additionally teaches a system and method including a focus timer that tracks the duration that said second browser is displayed in said foreground window (see paragraph [0050]).

18. Regarding claims 27 and 37, **Landsman et al.** additionally teaches a system and method wherein said media comprises one of a computer, a PDA, a cell phone and a television (see disclosure that the system is executed in a computer, Abstract).

19. Regarding claims 28 and 38, **Landsman et al.** additionally teaches a system and method wherein said event handler selects and returns one of a plurality of advertisements maintained at said Internet address (see paragraph [0104]).

20. Regarding claims 29 and 39, **Porn Rodeo** additionally teaches a system and method capable of opening a plurality of second browsers, each maintained in a separate background window, said event handler capable of receiving a link to an advertisement for each browser and loading a respective said advertisement into each said second browser while each said second browser remains in its respective said background window (see window.open and window.focus calls on page 1, lines 15-20,

code that would open an additional background window each time the web page was refreshed).

### *Response to Arguments*

21. Applicant's arguments with respect to claims 20-39 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Advertisement Banners** ("About Us - Advertisement Banners") discloses the fact that the company Advertisement Banners launched the SpecificPOP ad network in January 2000, and that the network specializes in the strategic placement of the Internet's highest performing ad unit, the pop-under.

**SpecificPOP** ("About SpecificPOP") discloses that SpecificMedia launched the SpecificPOP as network in 2000, and that the network specializes in pop under advertising.

**Chuang et al.** ("Bankruptcy of Wireless Camera Firm May Hurt California Brothers' Suit") discloses that the Vanderhook brothers launched AdvertisementBanners

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in 1999, and that the company focused on pup-under ads, which opens a browser window underneath your current window.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119. Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100; or fax (571) 273-2100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Luke S. Wassum  
Primary Examiner  
Art Unit 2167

lsw  
18 August 2006